

REMARKS

Claims 1-15 and 24-37 and 41 are pending. Claims 16-18 and 38-40 have been cancelled without prejudice to or disclaimer of the underlying subject matter. Claims 19-23 were previously cancelled without prejudice to or disclaimer of the underlying subject matter. Claims 1, 10, and 24 have been amended. Support for the foregoing amendment can be found throughout the specification and claims as originally filed, for example on page 150, lines 1-8. No new matter enters by way of the foregoing amendment.

I. Examiner Interview

Applicants thank Examiners Jiang and Spector for their courtesy during the interview on July 28, 2005 ("Second Interview"). In attendance at the Second Interview were Examiners Jiang and Spector, Applicants' representatives, David R. Marsh and Thomas E. Holsten, in-person, and James E. Butler, telephonically. During the Second Interview, Applicants discussed the remaining rejection. There was no agreement reached as to the teachings of the cited art, however, Applicants agreed to consider amendments to the claims to further define the claims over the cited references. Applicants particularly thank the Examiners for their suggestion that the addition of "wherein said subject's triglyceride levels are lowered" to claims 1, 10, and 24 might render the pending claims allowable. In light of this, Applicants have amended claims 1, 10, and 24 to recite "wherein said subject's triglyceride levels are lowered."

Applicants also brought to the Examiner's attention that they would submit a Supplemental Information Disclosure Statement with the current Response, directed to references cited in a European Patent Office proceeding. Applicants would also like to bring the Examiner's attention to the fact that it is possible that the Examiner may not have considered Kolterman, *et al.*, "Five-Day Dosing of Synthetic Exendin-4 (AC2993) in People with Type 2 Diabetes Reduces Post-Prandial Glucose, Glucagon and Triglyceride Concentrations," *Diabetologia* 43(suppl 1):A189 (2000), which was submitted with a Supplemental Information Disclosure Statement on May 22, 2001. Applicants respectfully request that the Examiner make of record this reference if it is not

already of record. A courtesy copy of the prior Supplemental Information Disclosure Statement, Form PTO-1449, and reference is enclosed.

II. Withdrawal of Rejections

Applicants thank the Examiner for indication of the withdrawal of the scope of enablement rejections of claims 1-15, 24-37 and 41 made in the Office Action mailed on November 17, 2004.

III. Rejection under 35 U.S.C. § 103(a)

Claims 1-14, 24-36 and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Karpe, *et al.*, “and in view of Beeley *et al.* WO 98/30231)... and Beers *et al.* (the Merck Manual, 1999, 17th edition, pages 200 and 2550), for the reasons set forth in the last Office Action mailed on 17 November 2004 at pages 4-5.” Final Action at page 3. Applicants respectfully disagree and traverse for at least the reasons that follow.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, and not be based on applicant’s disclosure. See M.P.E.P. §§2143.01 and 2143.03. Applicants’ remarks submitted in the response mailed March 14, 2005 regarding the requirements necessary to establish a *prima facie* case under 35 U.S.C. 103 are incorporated into the present response.

The present claims relate to the lowering of triglyceride levels. The claimed methods include identifying a patient with elevated triglyceride levels (or elevated postprandial triglyceride levels), followed by the administration of a therapeutically effective amount of an exendin or an exendin agonist.

As previously discussed and as acknowledged by the Examiner, Beeley, *et al.* does not discuss the use of exendins in the reduction of triglycerides (triglycerides are a subset of total plasma lipids, which include, *e.g.*, LDL, HDL, VLDL, and cholesterol). In

an attempt to overcome this, the Examiner points to Beers, *et al.* for alleged support and states that Beers, *et al.* points out that “triglyceride is one of two *major* types of plasma lipids.” Final Action at page 3. However, like Beeley, *et al.*, Beers, *et al.* does not discuss the use of exendins in the reduction of triglycerides.

Moreover, the discussions of the lowering of plasma lipids in Beeley, *et al.* are in the context of a reduction in food intake. As such, whatever else Beeley, *et al.* does disclose, the reference does not teach or suggest the identification of a subject having elevated postprandial triglyceride levels and the ability of exendins to specifically lower triglycerides. Applicants respectfully submit, therefore, that the Examiner has not met his burden of establishing a *prima facie* obviousness case.

The Examiner has acknowledged, “Karpe does not teach a method for lowering triglyceride levels with an exendin.” Office Action mailed November 17, 2004 at page 4. Accordingly, Karpe, *et al.* does not remedy the deficiencies of Beeley, *et al.* and Beers, *et al.* As such, the cited references taken in combination do not teach or suggest the claimed methods. For at least the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) of claims 1-14, 24-36 and 41.

Conclusion

In view of the above, each of the presently pending claims is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims, and to pass this application to issue. The Examiner is encouraged to contact the undersigned at (202) 942-5085 should any additional information be necessary for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D R. Marsh". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

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